



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/541,391	03/31/2000	Rick Dedrick	042390.P7954	3488

7590 12/11/2002

Donna Jo Coningsby
Blakely Sokoloff Taylor & Zafman LLP
12400 Wilshire Boulevard
7th Floor
Los Angeles, CA 90025

EXAMINER

ABDI, KAMBIZ

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 12/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/541,391

Applicant(s)

DEDRICK ET AL.

Examiner

Kambiz Abdi

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-14,16-22 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-14,16-22 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 3621

DETAILED ACTION

1. Claims 1-6, 8-14, 16-22, and 24 have been examined.

Claims 7, 15, and 23 canceled.

Claims 1, 8, 10, 16, and 17 have been amended.

Claims 1-6, 8-14, 16-22, and 24 have been considered

Response to Amendment

2. Applicant's arguments with respect to claims 1-6, 8-14, 16-22 and 24 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6, 8-14, 16-22, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,189,146 to Pradyumna K. Misra in view of 5892900 to Karl L. Ginter, and 6,269,343 to Matthew G. Pallakoff.

5. As for claims 1-6, 8-14, 16-22, and 24, Misra discloses an apparatus comprising;

- Claims 1, 10, 17; a repository for storing a volume license agreement (See Misra column 6, lines 50-68 and column 7, lines 1-11);
- Claims 1, 10; a repository for maintaining a purchase history (See Misra tables 3 and 4, column 9, lines 29-61, and column 4, lines 15-30);
- Claims 1, 10; a purchase generator (See Misra figures 3 and 4, column 2, lines 32-61).

Art Unit: 3621

- Claim 2; a clearinghouse, the clearinghouse being remotely connected to the pricing generator over a communications network (See Misra figures 1 and 3, column 3, lines 59-68, and column 4, lines 1-13).
- Claims 24, 3; the communications network is the Internet (See Misra column 4, lines 1-21).
- Claim 4; the clearinghouse is further remotely connected to at least one of a plurality of publishers, the publishers periodically transmitting a new volume licensing agreement to the clearinghouse (See Misra column 2, lines 47-68).
- Claim 5; the clearinghouse is further remotely connected to at least one of a plurality of distributors, the distributors periodically transmitting a new volume licensing agreement to the clearinghouse (See Misra column 2, lines 47-68).
- Claim 6, 20; purchase history is updated to reflect the transacted purchase (See Misra tables 3 and 4, column 4, lines 15-30, and column 9, lines 29-61).
- Claim 9; an electronic distribution mechanism to automatically install the purchased product (See Misra column 6, lines 20-45 and column 8, lines 35-52).
- Claim 13; include instructions to extract the volume license agreement from a remote clearinghouse (See Misra column 4, lines 49-68).
- Claim 14; storing instructions further include extracting updated information about the products license under the volume licensing agreement (See Misra column 11, lines 25-45 and column 15, lines 19-36).
- Claim 19; recording a history of purchases includes recording a point value associated with the purchase in accordance with the volume license agreement (See Misra column 2, lines 22-47 and column 4, lines 1-42).

Misra fails to teach the following features which are thought by Pallakoff and Ginter.

- Claim 1; a pricing generator to generate a purchase price for the product in accordance with the volume license agreement and the purchase history (See Pallakoff column 7, lines 15-59 and Ginter column 22, lines 26-68, column 23, lines 1-44, column 24, lines 9-68, and column 25, lines 1-35).

Art Unit: 3621

- a rules engine containing a set of rules for determining a discount step for the product in accordance with the volume licensing agreement (See Pallakoff column 7, lines 15-59 and Ginter column 22, lines 26-68, column 23, lines 1-44, column 24, lines 9-68, and column 25, lines 1-35).
- Claims 8, 16, 21; the rules engine further contains a set of rules for determining a discount step for the product in accordance with a profile of the user (See Pallakoff column 7, lines 15-59 or Ginter column 22, lines 26-68, column 23, lines 1-44, column 24, lines 9-68, and column 25, lines 1-35).
- Claim 1; the purchase price is generated in response to a purchaser request (See Pallakoff column 7, lines 30-59 or Ginter column 22, lines 26-68, column 23, lines 1-44, column 24, lines 9-68, and column 25, lines 1-35).
- Claims 11, 12; communicating the purchase price to the user in a visual display (See Pallakoff column 4, lines 42-63 or Ginter column 22, lines 26-68, column 23, lines 1-44, column 24, lines 9-68, and column 25, lines 1-35).
- Claims 18, 22; communicating the approval by the user to purchase in a response to the visual display (See Pallakoff column 7, lines 5-30 or Ginter column 22, lines 26-68, column 23, lines 1-44, column 24, lines 9-68, and column 25, lines 1-35).

Furthermore, Misra is not explicit on a pricing method of the digital content as is licensed, distributed and managed through its system. Even though Misra discloses the collection of purchase history but Misra is not clear about the purpose of this data being used for eventual pricing of the digital content to be delivered through the system. However, both Pallakoff and Ginter clearly teach a pricing generator. Ginter clearly teaches the usage of all types of information (Historical, time period purchasing, limit purchasing, and many other metering activities) collected by the licensing system in order to calculate a price for the further licensing of data to be paid by the end user. Collected information is used as a determinant tool to calculate discounts for an agreed upon levels of discount in the license agreement. Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the above teaching to create a more accurate and efficient system to track licensing digital

Art Unit: 3621

content and make available further obtaining of digital content in amore favorable discounted rates based on the volume purchasing history.

A volume discount can be set as a pre-determinant criterion of discounting in addition to or separate from the historical purchasing of the end user activities base on a license agreement (See applicants discloser page 2, paragraph 3 and page 3, paragraph 1 and 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have added a well-known practice of volume discount pricing method in conjunction with a past purchasing history to calculate a discount level, to a license management system such as Misra's. Since it has been held that broadly providing a mechanical or automatic means to replace manual activity such as calculating prices, discounts or such, which has accomplished the same result, involves only routine skill in the art. *In re Vernner*, 120 USPQ 192. This combination would have been obvious to one of ordinary skill in the art for greater efficiency and economy in the management of licensing and pricing of volume discounted goods or services.

Conclusion

6. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be reached on 9:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (703) 305-9768.

Art Unit: 3621

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington, D.C. 20231**

or faxed to:


(703) 305-7687 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-7749 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to:

**Crystal Park 5, 2451 Crystal Drive
7th floor receptionist, Arlington, VA, 22202**

**Abdi/K
December 9, 2002**


**JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600**